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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/179,945	10/27/1998	JOHN Q. ADAMS		6273

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EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 09/24/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/179,945

Applicant(s)

ADAMS ET AL.

Examiner

John R. Paradiso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

BIRENBAUM ET AL in view of NORMAN ET AL (US 5702305).

3. BIRENBAUM ET AL discloses a portable programmable apparatus for aiding a player in a game of bingo. The apparatus comprises a processor (26) with port connections for various I/O, memory, and power functions. The processor receives instructions from an input device comprising input keys (18) that allow the user to enter data associated with the game. The processor also receives information from a memory module (14) which contains stored blocks of data representing the configurations and serial numbers of a large set of bingo cards (both regular and paper cards) as well as the possible winning configurations. The processor sends data to an output device in the form of a display (16) that so that game information can be read by the user. (See BIRENBAUM ET AL columns 1-4 and figures 1 and 3.)

4. BIRENBAUM ET AL does not disclose the use of a security feature to prevent unauthorized access to stored data, the use of rechargeable batteries with a recharging circuit, the specific voltages used to power the apparatus, the specific winning combinations, or the storage

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of specific card schedules. BIRENBAUM ET AL also does not disclose using the apparatus to communicate with other similar apparatus' with a communications protocol.

5. NORMAN ET AL discloses a game system comprising a plurality of portable game aids (32), each with means for a user to input and receive instructions concerning a game. Each of the portable game aids is also provided with a transmitting/receiving means to enable each player to transmit/receive blocks of data representing game information or personal information between each other player via their portable game aid. The portable game aids can also transmit/receive information blocks between themselves and a first computer, designated the master unit. (See NORMAN ET AL column 3 lines 21-54, column 4 lines 25-30, and Figure 3.)

6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of NORMAN ET AL to use a communication protocol to connect to the processor of another user's portable game aid, as taught by NORMAN ET AL, to enable a user to interact with another game player by sharing or using their information (stored in the memory of their portable game aid) to increase the enjoyment and competitive spirit of the game, and also to enable the swift and accurate validation and payout upon fulfilling a winning combination in the case of interacting with a master unit

7. Regarding claim 5, the use of passwords and passcodes is well known in the art to secure any form of data stored on a computer and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of BIRENBAUM ET AL and NORMAN ET AL to connect a security feature to the processor to prevent unauthorized access to the stored information of the apparatus.

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8. Regarding claim 7, the use of rechargeable batteries is well known in the art to provide power to handheld electronic devices and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of BIRENBAUM ET AL and NORMAN ET AL to use rechargeable batteries that can be recharged by an external power source. Note that BIRENBAUM ET AL does specifically disclose the possibility of connecting the apparatus to an external power source.

9. Regarding claim 8, the use of low voltage direct current to power electronic equipment is well known in the art. Further, the use of specific voltages to power specific components depending upon their makeup and operational needs is also well known. The availability of -17Vdc, +5Vdc, and +12Vdc from the power supply to power the electronic components of the apparatus is an obvious matter of engineering design choice, since Applicant has not disclosed that the use of these particular voltages (which are common voltage requirements for many electronic components) solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any voltages that would meet the needs of the electronic components used in the apparatus.

10. Regarding claim 12, BIRENBAUM ET AL discloses the storage of common bingo win patterns in the memory. While BIRENBAUM ET AL does not specifically disclose which patterns these are, the winning combinations of X shape, picture frame, fill-up, U-shape, and C-shape are well known to those skilled in the art (as well as to all bingo players) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to program the memory of the combination of BIRENBAUM ET AL and NORMAN ET AL to know these winning combinations.

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11. Regarding claim 16, BIRENBAUM ET AL specifically discloses that the processor receives information from a memory module which contains the configurations and serial numbers of a large set of bingo cards. While the specifics of type, brand, cut, and collation are not disclosed, the use of electronic memory to store collations of this sort is well known in the art (storing collatable databases is, in fact, one of the primary purposes of computers) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to store in the memory module of BIRENBAUM ET AL a set of bingo cards cross-references by serial number, type, brand, cut, and collation in order to enable the game master to use the specific type of card for which they are licensed or simply used to.

Response to Arguments

12. Applicant's arguments filed 7/9/2003 have been fully considered but they are not persuasive.

13. Applicant states on page 8 of his Response that "For a claim to be obvious under 35 U.S.C. 103, each limitation must be taught or suggested by the prior art reference." Applicant then recites claim 1 with the following sections highlighted:

"a processor", which is shown in BIRENBAUM ET AL, Fig. 3, as (26);

"a readable memory having prestored blocks of data representative of predetermined numbers and also representative of predetermined patterns" furnished from a media having magnetic coded information which is accessible by means movable relative to said information of said media", which is shown in BIRENBAUM ET AL Fig. 1 as the memory module (14), which contains the recited blocks of data as magnetic coded information and is also movable relative to the media (i.e., removable);

"means connected to one of said ports for providing an interactive dialogue between a player using the apparatus and said processor", which is shown in BIRENBAUM ET AL Fig. 1 as port connections for various I/O, memory, and power functions. BIRENBAUM ET AL also shows input keys (18) that allow the user to enter data associated with the game (which I/O can be read as a port to the processor). The processor also receives information from a memory module (14) via a module input port. The processor sends data to an output device in the form of a display (16) (which I/O can also be read as a port from the processor) that so that game information can be read by the user.

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14. Applicant states on page 8 of his Response that “The Birenbaum reference does not suggest ‘a readable memory having prestored blocks of data (element b). In fact, the Birenbaum reference teaches away from the prestoring such information in the device (10) by providing a separate memory module (14) that is selected in accordance with a specific set of cards.”

However, the claims do not recite the prestored blocks of data as resident in the device that houses the processor. Claim 1, for instance, recites “a readable memory having prestored blocks of data representative of predetermined numbers and also representative of predetermined patterns furnished from a media having magnetic coded information which is accessible by means movable relative to said information of said media” and the memory module of BIRENBAUM ET AL reads on that aspect of the claims.

Examiner also notes that it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

15. Applicant states on page 9 of his Response that “Similarly, the Norman reference does not teach or suggest a device with ‘a readable memory having prestored blocks of data’ since no data ... are stored or are capable of being stored in the personal display units”.

However, NORMAN ET AL is used in the above rejection only to teach the use of a communication protocol to connect to the processor of another user’s portable game aid to enable a user to interact with another game player by sharing or using their information (stored in the memory of their portable game aid) to increase the enjoyment and competitive spirit of the

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game, and also to enable the swift and accurate validation and payout upon fulfilling a winning combination in the case of interacting with a master unit, so the argument is moot.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.

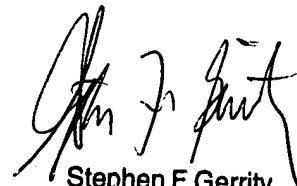


Examiner John Paradiso: (703) 308-2825

September 17, 2003

Additional Phone Numbers:

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